

RemarksRestriction Requirement

In the Office Action, the examiner has issued a restriction requirement and requires election of one of the following groups under 35 U.S.C. § 121:

Group I: Claims 1-4, 8-10, drawn to reducing BNIP3 mRNA in a cell, classified in class 514, subclass 44.

Group II: Claims 1, 5-10, drawn to interfering with BNIP3 protein function in a cell, classified in class 435, subclass 4.

Applicant hereby elects with traverse Group II (Claims 1, 5-10), drawn to interfering with BNIP3 protein function in a cell, classified in class 435, subclass 4. Applicant traverses the restriction requirement because the subject matter of Groups I and II are related (both being directed to reducing Bnip3 activity in a target cell) and a search for both groups would not be an undue burden on the office.

The Office Action cites MPEP §808.01 in support of its argument that the subject matter of Groups I and II is unrelated because reducing BNIP3 mRNA and interfering with BNIP3 protein function are not disclosed as useful together and have different modes of operation. Applicant respectfully disagrees. §808.1 states:

Where the inventions claimed are independent, i.e., where they are not connected in design, operation, or effect under the disclosure of the particular application under consideration (MPEP § 806.04), the facts relied on for this conclusion are in essence the reasons for insisting upon restriction. This situation, except for species, is but rarely presented, since persons will seldom file an application containing disclosures of independent things. (Emphasis added).

In contrast to the Office Action's assertion, the specification makes clear that the subject matter of Groups I and II is connected in effect – i.e., both groups are directed to a method for preventing or reducing hypoxia-acidosis induced injury to a cell by reducing BNIP3 expression or activity in a cell. Although this can be accomplished by many different techniques including manipulating amounts of RNA and/or protein, these techniques are all related because they operate similarly to achieve the same effect. Supporting this, it is well known that reducing the amount of mRNA encoding a particular protein in a cell generally causes a reduction in the amount of the particular protein in the cell.

MPEP §808.1 stresses that the presentation of inventions not connected in design, operation, or effect in a single application is rare "...since persons will seldom file an application containing disclosures of independent things." If the subject matter of Groups I and II were indeed independent as alleged, it is difficult to imagine how a claim encompassing both groups could even be drafted (see claim 1 encompassing both Groups I and II).

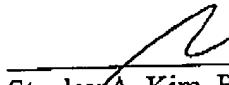
A search for Groups I and II would not be unduly burdensome because the subject matter of both groups is so closely related. For example, in conducting such a search, a diligent examiner would be searching for prior art that indicates or suggests that reducing BNIP3 activity by any means could modulate hypoxia-acidosis induced injury to a cell – not just whether RNA manipulation or just protein manipulation would accomplish this. Accordingly, a search for the subject matter of Groups I and II would not be unduly burdensome. Withdrawal of the restriction requirement is therefore respectfully requested.

The examiner is cordially invited to call the undersigned if clarification is needed on any matter within this response, or if the examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Applicant's attorney would also appreciate if the examiner could update the record to correctly reflect that the attorney docket number in the instant application is 8002-2.

Respectfully submitted,

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Stanley A. Kim, Ph.D., Esq.
Registration No. 42,730
RUDEN McCLOSKY, SMITH,
SCHUSTER & RUSSELL, P.A.
222 Lakeview Avenue
Suite 800
West Palm Beach, FL 33401-6112
Telephone: (561) 838-4512
Facsimile: (561) 514-3469

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